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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,404	12/01/2000	Satoshi Nishikawa	862.C2066	1364
5514 7590 04/16/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER QIN, YIXING	
			ART UNIT 2625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/726,404	Applicant(s) NISHIKAWA, SATOSHI	
	Examiner Yixing Qin	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 and 27-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/25/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to applicant's amendment received 1/25/07, all requested changes have been entered.

Response to Arguments

Applicant's arguments filed 1/25/07 have been fully considered but they are not persuasive. The first argument is that the applicant's invention is that the Shima reference disclose a spooler and a generating unit. Although Shima does not use the words spooler and generating unit, Shima discloses various modules and their functions, which are equivalent to the functions of a spooler and generating unit. Fig. 7 shows memory for storing the various information, and Figs. 13 and 14 both have steps in which intermediate data is converted for printing.

The argument also state that putting the controller 7 in a print server would not work the same as the print control apparatus in the applicant's invention because it cannot save the intermediate data and generate test and normal prints. The Examiner disagrees. The controller is what enables the generation of the prints to be executed and it contains storage areas , such as that of Fig. 7, for storing intermediate data. The Examiner wants to also note that a print server does not necessarily have to be a different entity than a host computer, they can be the device (i.e. a print server is able to generate data and process it for printing)

The arguments further state that the Shima and Williams references do not disclose a generating unit that reads the intermediate data saved in the spooler and

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generates print data based on the setup related to the content to be printed and the intermediate data with the printer driver when the setup related to the content to be printed has been changed. However, from Figs. 13 and 14 of Shima, the flow charts disclose that a setup is changed (i.e. copies decremented) before the conversion of intermediate data to print data. Again, the Shima reference discloses equivalent functions, even though they don't call the module a generating unit.

The Shima reference still teaches all of the aspects of the currently claimed invention. This action is made final. Please see more detail below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- I. Claims 6-9, 11, 27-30, 32-35, and 37-40 rejected under 35 U.S.C. 102(e) as being anticipated by Shima et al (U.S. Patent No. 6,104,498) in view of Official Notice.

Regarding claims 6, 27, 32 and 37, Shima et al discloses a print control apparatus as a host computer, which is connected to an external printing apparatus through an interface and executes a print driver (column 5, lines 6-14) which generates

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print data described in the page description language (Fig. 10, item 72 shows a job language interpretation task) to be interpreted by the external printing apparatus (Fig. 2 and column 14, lines 58-65), comprising:

It does not explicitly disclose a spooler that saves intermediate data to be converted into the print data and converted from graphic information generated by a graphic engine based on a print request from an application, together with a designated number of copies of a document to be printed based on the saved data;"

However, Shima discloses the storage of the data and the copies in Fig. 7 and column 8, lines 30-33. The usage of a graphics engine to generate graphic information from an application is well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used conventional techniques to transfer print information.

The motivation would have been to allow for easier implementation by using a conventional method.

Therefore, it would have been obvious to adjust Shima to obtain the invention as specified.

a spool file manager that checks if a print instruction is a test print instruction, that changes the number of copies to 1 when the test print is instructed, and that outputs the intermediate data saved in the spooler together with the number of copies which has been changed to 1 for the test print to be printed in response to the print

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instruction for printing at the print apparatus; (Fig. 14, S95-S101 and column 14, lines 18-46; also see Fig. 12 that shows the print management task 74 - especially S59 and S60 - and column 13, line 66 – column 14, line 4)

a generation unit that generates the print data with the print driver based on the intermediate data and the number of copies which has been changed to 1 for the test print outputted by said spool file manager; (Fig. 14 , item S100) and

a transmission unit that transmits the print data generated by said generation unit to the printing apparatus, (Fig. 2, item 9)

wherein when a test print is instructed, the said generation unit generates the print data which is described in the page description language with the number of copies which is has been changed into 1 for a test print, and

wherein when normal print of the document is instructed after the print data for the test print generated by said generating unit has been transmitted to the printing apparatus, said generating unit reads the intermediate data saved by the spooler and generates the print data which is described in the page description language. (Fig. 14 S100, which takes place after steps S95, S97 and S98 that indicate that a print job is a test print. Print information is then converted in S100 and printed)

Regarding claims 7, 28, 33 and 38, Shima et al discloses wherein when the print instruction is not the test print instruction, said spool file manager deletes the output data from said spooler. (Fig. 14 S96 and column 14, lines 23-25)

Regarding claims 8, 29, 34 and 39, Shima et al discloses wherein when the print instruction is the test print instruction, said generation unit generates the print data with a number of copies having a value obtained by subtracting the number of copies output in a test print process from the designated number of copies after said spool file manager outputs the data. (Fig. 14, S97 and column 14, lines 25-29)

Regarding claims 9, 30, 35 and 40, Shima et al discloses wherein the intermediate data stored in said spooler is data (Fig. 7) before being converted into a format to be output to the printing apparatus, and when the print instruction is the test print instruction, said spool file manager changes a setup related to a content to be printed associated with the intermediate data saved in said spooler after said spool file manager outputs the data, and (column 14, lines 25-29)

wherein said generating unit reads the intermediate data saved in the spooler and generates print data based on the setup related to the content to be printed and the intermediate data with the printer driver when the setup related to the content to be printed has been changed. (Figs. 13 and 14 of Shima show the flow charts disclose that a setup is changed (i.e. copies decremented) before the conversion of intermediate data to print data.)

Regarding claim 11, Shima et al discloses a print system which is constructed by connecting a print control apparatus of claim 6 and a printing apparatus and prints based on data output from output step of said print control apparatus. (Fig. 2)

II. Claims 10, 31, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498) in view of Official Notice and further in view of Williams et al (U.S. Patent No. 5,237,923).

Regarding claims 10, 31, 36 and 41, Shima et al discloses wherein said spool file manager changes the number of copies associated with the data saved in said spooler after said spool file manager outputs the data when the print instruction is the test print instruction, (Fig. 14 S97 and column 14, lines 25-29)

It does not explicitly disclose “resets the number of copies to the designated number of copies when the print instruction is not the test print instruction and when the number of copies has been changed.”

However, the secondary reference by Williams et al teaches in column 8, lines 61-68 and column 9 line 3, the printing of “proof copies of the original document, the number being determined by the operator’s instructions entered via keyboard...” and when “...acceptable, the operator can instruct the press to print the required number of final copies.” Also, Williams et al takes into account that “[i]f changes are required, new printing plates can be made...” The point here is that Williams et al’s reference accounts for changes in “proof” (test) copies and the ability to change the number of copies to any value based on user input.

Shima et al and Williams et al are combinable because both are in the art of printing multiple copies.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a step of resetting the number of copies to a designated value when test printing is involved as taught by the Williams et al reference in light of the Shima et al invention

The motivation would have been to be able to print the appropriate number of copies if the test print is deemed to be acceptable.

Therefore, it would have been obvious to combine Shima et al and Williams et al to obtain the invention as specified.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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